

Application No. 09/894,371
Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 1772
Amdt. AF dated June 3, 2003
Reply to Final Office Action of March 3, 2003
Attorney Docket No. 1217-010927

REMARKS

Claims 1, 5, 8-12, 16, 19-20, 24, 27 and 28 are pending in the present application. Claim 1 has been amended to indicate the total thickness of the multi-layered base and removal of the polymethyl methacrylate resin from the claim language. Support for the amendment can be found on page 9, lines 18 – 23 of the specification. Claims 8 and 12 were amended to conform with amended claim 1.

Reconsideration is respectfully requested in light of the above amendment of claims 1, 8, and 12 taken with the following remarks.

Additionally, reconsideration of holding this Office Action as Final is respectfully requested. Claim 2, in the Office Action dated September 23, 2002, was not rejected on the merits, but under 35 U.S.C. § 112, first paragraph. The limitations of claim 2 were incorporated into claim 1. Therefore, the rejection of amended claim 1 (incorporating the limitations of cancelled claim 2) is a first action on the merits of the claim and classification of this Office Action as Final is improper. Applicants respectfully request that it be withdrawn.

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness because of the use of the term “Charpy.” This term has appeared within United States Patent No. 5,393,607 to Kawasaki et al. (hereinafter “Kawasaki”) in column 43, line 19. The Charpy impact strength is defined in JIS (Japanese Industrial Standard) K-7111, and corresponds to ISO 179. Therefore, the term is a well-known and

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recognized term in the art and is not indefinite, and Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claims 1, 5, 8-12, 16, 19-20, 24, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as being obvious over JP-11-309813 (hereinafter “JP ‘813”) in view of Kawasaki. The Examiner suggests that it would have been obvious to one of ordinary skill in the art at the time of invention to have modified JP ‘813 by replacing the base film with the multi-layered film disclosed by Kawasaki in order to provide a starting material for a glazing substrate that exhibits improved hardness and stiffness. However, Kawasaki does not disclose the multi-layered base of the present invention. The thickness of the transparent plastic material of Kawasaki is at least 0.2 mm, preferably 0.5 to 3 mm (see Kawasaki, column 4, lines 4-8). However, Kawasaki only demonstrates a thickness as low as 1 mm and, therefore, any base with a thickness less than 1 mm is only speculative.

Therefore, one with ordinary skill in the art would not look to Kawasaki to prepare coated bases of less than 350 μm as in the presently amended claims. Further, the base film actually disclosed in Kawasaki is a monolayer (see Kawasaki, (1) to (10) of column 41, line 55 to column 42, line 17). Among them, only (3), i.e., RMP-3 has a laminated structure. RMP-3 is a laminate of polycarbonate and polymethyl methacrylate. However, as now amended, the use of polymethyl methacrylate is not included in the present claims. As such, Kawasaki does not disclose the multi-layer base of the present invention. Accordingly, the present invention is not rendered obvious from the combined

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teachings of JP '813 and Kawasaki, and the rejection under 35 U.S.C. 103(a) should be withdrawn.

Claims 1, 5, 8-12, 16, 19-20, 24, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as being obvious over JP '813 in view of U.S. Patent No. 3,810,815 to Welhart et al. (hereinafter Welhart). Welhart does not disclose the multi-layered base of the present invention. The thickness of the laminate of Welhart is thicker than that of the present invention (see examples in Welhart). Further, the laminate of Welhart comprises a layer of polycarbonate resin and a layer of cast polymethyl methacrylate (see claim 1 of Welhart). However, as now amended, the present claims no longer include polymethyl methacrylate. Since Welhart does not disclose a multi-layered base as in the present claims, which do not include polymethyl methacrylate, the combined teachings of JP '813 and Welhart no longer render the present invention obvious, and the rejection under 35 U.S.C. 103(a) should be withdrawn.

Claims 1, 5, 8-12, 16, 19-20, 24, and 27-28 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,391,400 to Russell et al. (hereinafter "Russell") in view of Kawasaki. The Examiner indicates that it would have been obvious to one of ordinary skill in the art to have modified Russell by replacing any of the base films "S" with the multi-layered film as taught by Kawasaki in order to provide a starting material for a glazing substrate that exhibits improved surface hardness and stiffness over prior art by laminating the two adhesives together to form a multi-layered laminate that has the desired features of partly high surface hardness,

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excellent scratch resistance, stiffness, impact resistance, heat resistance, chemical resistance, and weatherability.

Russell fails to teach the present invention's claimed base thickness and resin combination. Further there is no motivation for one skilled in the art based on Kawasaki to modify Russell. Moreover, the mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989) (quoting In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Therefore, the 103(a) rejection based on Russell in view of Kawasaki is improper and should be removed.

Claims 1, 5, 8-12, 16, 19-20, 24, and 27-28 stand rejected under 35 U.S.C. 103(a) as being obvious over Russell in view of Welhart. The Examiner asserts that it would have been obvious to one skilled in the art to have modified Russell by replacing the single layered base "S" with a multi-layered film of PMM and polycarbonate as taught by Welhart in order to replace the use of either a single polycarbonate film layer or a single polymethyl methacrylate film layer such that the multi-layered structure achieves the advantages of both acrylic and polycarbonate, including weatherability and impact resistance.

Russell fails to teach the present invention's claimed base thickness and resin combination. Further, there is no motivation for one skilled in the art based on Welhart to modify Russell as the Examiner has done. Moreover, the mere fact that the

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prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d at 117. Therefore, the 103(a) rejection based on Russell in view of Welhart should be withdrawn.

Claims 1, 5, 8-12, 16, 19-20, 24, and 27-28 stand rejected under 35 U.S.C. 103(a) as being obvious over United States Patent No. 5,956,175 to Hojnowski (hereinafter “Hojnowski”) in view of Kawasaki and U.S. Patent No. 6,103,370 to Onozawa et al. (hereinafter “Onozawa”). The Examiner indicates that it would have been obvious to one of ordinary skill in the art to modify Hojnowski by replacing either of the base films with the multi-layered film as taught by Kawasaki. Additionally, the Examiner indicates that it would have been obvious to one of ordinary skill in the art to modify Hojnowski by providing the adhesive layer with a release liner as taught by Onozawa in order to protect the adhesive prior to affixing the film to the desired surface.

Hojnowski does not teach the same thickness of the multi-layered base as in the present invention, nor does Hojnowski teach the same specific resins. The purpose of having the multi-layered base no thicker than 350 μm is to provide a hard coat film that can be easily stuck onto windowpanes, plastic boards, etc. However, if the thickness is as large as the secondary references, it would be difficult to stick the sheet onto windowpanes, etc. Additionally, Onozawa fails to teach the multi-layered base in the present invention. The Examiner has not met his burden of demonstrating any motivation based on Kawasaki and Onozawa to modify Hojnowski. The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art

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suggested the desirability of the modification. In re Laskowski, 871 F.2d at 117.

Therefore, the 103(a) rejection based on Hojnowski in view of Kawasaki and Onozawa should be withdrawn.

Claims 1, 5, 8-12, 16, 19-20, 24, and 27-28 stand rejected under 35 U.S.C. 103(a) as being obvious over Hojnowski in view of Welhart and Onozawa. The Examiner states that it would have been obvious to one of ordinary skill in the art to have modified Hojnowski by replacing either or both layers #10 and #16 (from Fig.1 of Hojnowski) with a multi-layered film of PMM and polycarbonate as taught by Welhart in order to replace the use of either a weather-resistant or an impact-resistant film layer such that the multi-layered structure achieves the advantages of both acrylic and polycarbonate, including weatherability and impact resistance. Additionally, the Examiner asserts that it would have been obvious to modify Hojnowski by providing the adhesive layer with a release liner as taught by Onozawa to protect the adhesive layer prior to use.

Hojnowski does not teach the same thickness of the multi-layered base as in the present invention, nor does Hojnowski teach the same specific resins. Further, there is no motivation provided to modify Hojnowski. The purpose of having the multi-layered base no thicker than 350 μm is so that the hard coat film can be easily stuck onto windowpanes, plastic boards, etc. However, if the thickness is as large as the secondary references, it would be difficult to stick the sheet onto the windowpanes, etc. Additionally, Onozawa fails to teach the multi-layered base in the present invention. The

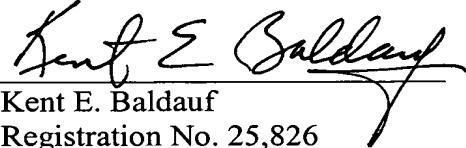
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Examiner has not met his burden of demonstrating any motivation based on Welhart and Onozawa to modify Hojnowski. The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d at 117. Therefore, the 103(a) rejection based on Hojnowski in view of Welhart and Onozawa should be withdrawn.

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of claims 1, 5, 8-12, 16, 19-20, 24, 27 and 28 are respectfully requested.

Respectfully submitted,

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